

## **REMARKS/ARGUMENTS**

Paragraph 0020 has been amended to correct a minor typographical error. Claim 1 has been amended to further define over Moorehead. No new matter has been added by this amendment. Reconsideration of this Application and entry of this Amendment after Final are respectfully requested. The proposed amendment places the claims in better form for appeal. In view of the amendments and following remarks, favorable consideration and allowance of the application is respectfully requested.

### **35 U.S.C. §102 Rejections**

Claims 1-3, 9, 12 and 14 stand rejected under 35 U.S.C. §102(b) as being anticipated by Moorehead (US Patent 5,147,332). Applicant traverses this rejection because Moorehead fails to teach all the elements of claim 1, as currently amended.

The Examiner states that Moorehead includes a disclosure of “struts and apertures interspaced around the circumference of a proximal portion of the catheter.” The Examiner also states that Applicant has not defined what he regards as the proximal portion, and further states that “any portion not at the distal end can be regarded as a proximal portion.”

Claim 1 has been amended to define “. . . a proximal portion of the catheter that extends out of the patient during use.” Support for this amendment may be found *inter alia* in paragraphs 003 and 0020. The claimed catheter can be a guidewire:

Catheter 110 may be, for example, a hollow guidewire. . .  
(paragraph 0020).

The guidewire or catheter has a portion that extends out of the patient during use:

Typically, a first treatment catheter is advanced over the guidewire, withdrawn, and then fully removed from the portion of the guidewire that extends out of the patient's vessel (emphasis provided, paragraph 003).

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Moorehead fails to teach “struts and apertures interspaced around the circumference of a proximal portion of the catheter that extends out of the patient during use,” as now required in claim 1. Rather, Moorehead discloses a multi-valve catheter wherein the valves are disposed near the distal end of the catheter such that the valves are disposed entirely within the patient during use of the invention, i.e.

During infusion, the lips of the slit valve open outwardly into the blood vessel of the patient permitting fluid to flow through the catheter and into the blood vessel (column 2, lines 26-29).

An alternative situation is that the side of the catheter in which the slit valve is formed may occasionally come to rest against or in close proximity to the wall of the blood vessel in which the catheter tip is disposed (column 2, lines 49-52).

Any characterization of Moorehead that places valves in a proximal portion of the catheter that extends out of the patient during use would be contrary to the teachings of the reference and would render such an embodiment of Moorehead unusable for its intended purpose. Thus, Moorehead cannot be considered to anticipate claim 1 because nowhere does Moorehead teach locating valves in a proximal portion of the catheter that extends out of the patient during use. Applicant requests that the rejection be withdrawn.

Claims 2-3, 9-12 and 14 depend directly or indirectly from claim 1 and are therefore patentable for at least the reasons described above. Further, the Examiner has failed to point out any parts of Moorehead that are considered to teach the specific limitations of claims 2-3 and 9-12, as required under 37 C.F.R. § 1.104 (c) 2.

*Allowable Subject Matter*

Applicant gratefully acknowledges the Examiner’s indication that claims 10 and 11 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Conclusion**

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (978) 739-3075 (eastern time).

Date: August 9, 2005

Respectfully submitted,

  
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